

REMARKS

Claim 33 is currently pending in the current application. In the present Office Action, the Office rejected claim 33 as being anticipated by U.S. Patent No. 6,915,271 (Meier et al). The Manual of Patent Examining Procedure, Section 2131 states that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states that “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Office has suggested that the Meier reference (and more specifically columns 40 and 41 of the Meier reference) discloses “a browsable catalog for searching the items” offered for sale, as required by claim 33. At no point, however, does the Meier reference expressly disclose a browsable catalog. As such, the Office can only maintain this objection if such a catalog is inherently described in the Meier reference.

A rejection based on inherency must include a statement of the rationale or evidence tending to show inherency. *See* Manual of Patent Examining Procedure at § 2112. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *See id.* citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *See In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Moreover, a rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Claim 33 requires a "browsable catalog for searching the items" offered for sale. The section of the Meier reference in which the Office relies upon discloses an online merchant that offers goods for sale. Because it is not necessary for an online merchant to offer browsable catalogs for the items he or she sells, this disclosure in the Meier reference does not, by itself, inherently disclose the claimed feature.

As such, Applicants believe that claim 33 is in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Dated: February 12, 2007

By: Ronald H. Spuhler
Ronald H. Spuhler
Reg. No. 52,245

McAndrews, Held & Malloy, Ltd.
500 West Madison Street - Ste. 3400
Chicago, Illinois 60661
(312) 775-8000